

Neifeld Docket No: INVE0010-5

Application/Patent No: 09/879,825

USPTO CONFIRMATION NO: 4591

File/Issue Date: 6/12/2001

Inventor/title: Barnett/M/S for Electronic Distribution of Product Redemption Coupons

Examiner/ArtUnit: Duran/3622

ENTITY STATUS: LARGE

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

1. **THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES
WHICH MAY BE REQUIRED, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT
ACCOUNT NUMBER 50-2106.**

2. **FEES (PAID HEREWITH BY EFS CREDIT CARD SUBMISSION) \$:**

3. **THE FOLLOWING DOCUMENTS ARE SUBMITTED HEREWITH:**

37 CFR 41.41 REPLY BRIEF

4. **FOR INTERNAL NEIFELD IP LAW, PC USE ONLY**

Disbursements: BankAcct#, PClaw billing matter, G/L, check, entry date, amount: 0 6

Service Fees: Amount/CreditAtty/entry date/Services: 0

INITIALS OF PERSON WHO **ENTERED** ACCOUNTING DATA: RAN

ATTORNEY SIGNATURE (AUTHORIZING DEPOSIT ACCOUNT)

DATE: 10/31/2011

SIGNATURE: /RichardNeifeld#35,299/

Printed: October 31, 2011 (11:54am)

RICHARD NEIFELD, REG. NO. 35,299

ATTORNEY OF RECORD

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ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.41 REPLY BRIEF IN RESPONSE TO 10/28/2011 ANSWER

Sir:

In response to the 10/28/2011 Answer, consider this reply brief.

**B. UPDATED 37 CFR 41.37(c)(1)(ii) RELATED APPEALS AND
INTERFERENCES**

There are related appeals.

The related appeals are:

Docket No.	AppNo	AppealNo	Appeal docket date
INVE0010-1	NO APPEAL		
INVE0010-2	NO APPEAL		
INVE0010-3	09/754,378	BPAI, 2005-2439	DECIDED
INVE0010-3	09/754,378	CAFC, 2007-1047	DECIDED
INVE0010-4	09/879,823	2005-2686	DECIDED
INVE0010-5	09/879,825	2007-0794	DECIDED
INVE0010-5	09/879,825	Not yet assigned (this appeal)	
INVE0010-6	10/871,381	2011-007957	4/28/2011
INVE0010-7	11/056,171	2011-010648	7/8/2011
INVE0010-8	12/247,549	Not yet assigned	
INVE0010-9	11/056,160	NO APPEAL	
INVE0014-1	09/321,597	BPAI	DECIDED
INVE0014-1	09/321,597	CAFC	DECIDED
INVE0015-1	09/451,558	2009-006888	DECIDED
INVE0016-1	09/537,793		
INVE0017-1	09/543,735		

All these cases have the same inventive disclosure and 35 USC 120 priority claimed date.

REPLY TO EXAMINER'S ANSWER

Answer at 24:17-18 states that "On page 15, Appellant questions what a prior BPAI decision on this case has stated about the Cameron reference." In reply, I submit that is not accurate. The brief does not question what the BPAI decision "stated". Instead, it questions the examiner's characterization of what the BPAI stated, and, at Brief page 16-17, clarifies the implications of those statements, concluding that "Accordingly, the rejection based upon Von Kohorn and Cameron, as an alternative to Von Kohorn and Saigh, is barred for the same reasons that the rejection based upon Saigh. And since the examiner relies upon Cameron as an alternative to Saigh, the rejections based upon the combinations of Von Kohorn, Saigh, and Cameron, are barred." Brief at 17:6-9.

Answer at 16:4-10 asserts that the electronic coupon redemption is open to "broad interpretation" based upon that concept being "minimally described" in our specification, in reference to claims 68 and 71. In reply, that assertion is not relevant because it does not address the claim limitations. See brief page 6 noting the last paragraph showing support for claims 68, 71, which reads:

"said server system being programmed to respond to receipt from a coupon redemption network address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed {Numbered page 12:26 to 13:2; page 25:29 to page 26:12 (concept of validation); numbered page 26:9-12 "disallow further redemption"; numbered page 26 line 25 (electronic redemption

concept); numbered page 27:5-21 (used coupon deletion routine 32e; numbered page 30:20-28 embodiment (physical layout of functions within the system matter of designer choice; expanded redemption center)}."

Answer at 26:17-18 notes "numerous related cases" and at that the CAFC has affirmed rejections of claims in the related cases, and Answer at 27 to 29 reiterates characterizations about CAFC decisions in related cases. In reply, please note our characterization of these decision, upon review of these decisions. Also note that the claims, and claim limitations, in each related case, differ from the claims in this case.

Answer at 38:1-20 argues that Von Kohorn (VK) (at 17:10-30, 20:30-45; 16:17-25 as quoted on page 38 in the Answer) discloses the claimed "comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed". In reply, I disagree. VK at 17:10-30 discloses comparing a card and a coupon presented in person by a user to someone at a redemption facility location. That "comparing" is not comparing against redemption data. VK at 20:35-45 "one time" coupon refers to a coupon for winning a game/quiz show. See VK at 20:18-19. That on-time coupon concept does not disclose "comparing" against redemption data. VK at 16:17-25 discloses periodically replacing the paper rolls, and limiting redemption to a specified time period. Those concepts do not disclose "comparing" against redemption data. None of those VK passages disclose the claimed comparing, and none of them discloses that the comparing results in a determination whether said particular coupon was previously redeemed (claimed as "to thereby determine whether said particular coupon was previously redeemed").

Answer at 39 lines 18-20 asserts that "Hence, Von Kohorn clearly discloses a one-time use coupon and comparing validation number on coupons then invalidating the number after redemption so that a coupon is redeemed only once.". In reply, I disagree. VK discloses mutilating a paper coupon when the coupon is presented for redemption such that it could not be presented again for validation. That mutilation of the coupon upon validation teaches away from determining whether a coupon presented for redemption has previously been redeemed, which is what claims 68, 71 define.

Truly, /RichardNeifeld/

RICHARD NEIFELD, REG. NO. 35,299

ATTORNEY OF RECORD

RAN

Date/time code: October 31, 2011 (11:54am)

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